

REMARKS:

The Examiner noted that claims 14, 17, 20, 23 and 25 are pending in the application, and the Examiner rejected all claims.

By this Amendment, claims 14, 17, 20, and 23 have been amended. Claims 1-13, 15, 16, 18, 19, 21, 22, 24, and 25 remain cancelled. New claim 26 is added herein. No new matter has been presented.

The Examiner's rejections are traversed below, and reconsideration of all rejected claims is respectfully requested.

Thus, claims 14, 17, 20, 23 and 26 are pending and under consideration.

OBJECTION TO CLAIMS:

At item 3 on page 2 of the Office Action, the Examiner objected to claims 14, 17, 20 and 23 due to informalities and requested that these claims be double spaced.

Appropriate spacing has been applied to all pending claims.

Therefore, withdrawal of the objection is respectfully requested.

REJECTIONS UNDER 35 USC §103:

In item 4 on page 2 of the Office Action the Examiner rejected claims 14, 17, 20, 23, and 25 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,684,195 (Deaton) in view of U.S. Patent No. 6,529,940 (Humble). The Applicants respectfully traverse the Examiner's rejections of the remaining claims.

Deaton and/or Humble do not teach or suggest a system that "... converts predetermined points into a time period for supplying the electronic information service" and "decreases the cumulative issued points according to a time spent for providing the electronic information service which is redeemed by the customer's request with the cumulative issued points", where information is provided for displaying the decreased customer's cumulative issued points "in proportion to the time period for supplying the electronic information service", as recited for example in claim 14. See also claims 17, 20 and 23 reciting similar features.

Deaton and Humble are silent regarding "converting the predetermined points into a time period for supplying electronic information service". Therefore, it is impossible to display, on a

customer terminal, the decreasing the cumulative issued points on a time basis "in proportion to a time period for supplying the electronic information service" in Deaton and Humble.

At least on page 4 of the outstanding Office Action, the Examiner appears to compare redeeming of coupons in Fig. 33 of Deaton with the decreasing of the cumulative issued points according to "a time spent for providing the electronic information service", as recited in claim 14 for example. Deaton is limited to updates to the coupon database only based on items purchased where redemption of an item purchased is reflected (see, Fig. 33 including corresponding text). Meaning, there is no mention in Deaton regarding adjusting or decreasing points based on "a time spent for providing the electronic information service."

The Examiner acknowledges that Deaton does not teach or suggest displaying the decreased customer's cumulative points during the time the electronic information service is provided, but relies on Humble as teaching the same. Humble is directed to displaying messages of a manufacturer or retailer on display terminals that are located in a retail store (see, Fig. 1).

However, Humble does not teach or suggest "**displaying the decreased customer's cumulative issued points in proportion to the time period for supplying the electronic information service**, on a screen of the customer terminal during the time the electronic information service is provided to the customer terminal" (emphasis added), as recited in claim 14 for example.

At item 9 on page 5 of the Office Action, the Examiner asserts that any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning. Applicants respectfully submit that the Examiner's conclusion of obviousness is based on improper hindsight reasoning. One of ordinary of skill in the art would not be motivated to combine the incentive coupons based on customer shopping histories in Deaton with the display of messages to the customers from manufacturers without regard to the shopping history of the customers as discussed in Humble.

According to MPEP 2143.01, the modification proposed in the Office Action cannot render the prior art unsatisfactory for its intended purpose. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). Assuming, *arguendo*, that the teachings of Deaton and Humble could be combined, it is not possible for the system to provide transaction data that is specific to a customer's identification code in Deaton using the display of general manufacturer messages to all customers in-store as asserted in Humble.

Further, in this case, combining the teachings of Deaton and Humble, would render Deaton inoperable for its intended purpose of providing incentives in response to customer shopping histories when using the messages in Humble without considering the shoppers' past history.

The claimed invention provides a service as an incentive in accordance with the cumulative issued points obtained at every transaction, where the service is presented in the form of an electronic information service to be electronically transmitted to the customer's terminal from an electronic information source. In this regard, neither Deaton nor Humble teach or suggest feature(s) of an electronic information service as redemption of the issued points.

The Examiner maintains that it is old and well known to provide services electronically in order to avoid the need for the customer to have to wait for the goods or services, or having to pick up the same from a remote location. The Applicants respectfully disagree with the Examiner's assertion and incorporate herein the specific reasons set forth in the Amendment of November 17, 2008.

Further, Applicants respectfully submit that Official Notice without documentary evidence to support an Examiner's conclusion in this case is impermissible. The claimed invention is not limited to general display (or providing) of information to a customer, as seems asserted on page 3 of the outstanding Office Action, but to a specific technique of providing an electronic information service.

Further, even assuming the Examiner's assertion and rejection based on well known is valid, the claimed invention is distinguishable as discussed above.

Therefore, withdrawal of the rejection is respectfully requested.

NEW CLAIM:

Deaton and/or Humble do not teach or suggest "converting transaction related points to a time period" and "decreasing an amount of the time period in proportion to a lapse of time during which the electronic service is transmitted to the customer as requested", as recited in claim 26.

Instead, Deaton is limited to redemption of coupons for purchase of items and Humble only relates to display of manufacture messages to a customer without consideration to the customer's purchase history.

It is submitted that new claim 26 is patentably distinguishable over the cited references.

CONCLUSION:

There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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